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R E M A R K S

This Amendment is submitted as a full and complete response to the Second and Final Office Action mailed April 5, 2005. By this Amendment, applicant has canceled Claims 11 and 18 and has now once again amended extensively independent Claims 9 and 16. Accordingly, it is now believed that amended independent Claims 9 and 16 and the remaining claims dependent thereon have been placed in condition for allowance.

In this second and Final Office Action, the Examiner appears to be adamant in his position and has rejected Claims 9, 11-14, 16 and 18-21 under 35 USC 103 as being unpatentable over Curry, U.S. Patent No. 6,266,223, taken in view of the teachings of Nabell et al., U.S. Patent No. 6,377,435 and Takeuchi, U.S. Patent No. 6,040,972. The Examiner has set forth in detail his reasons for these rejections on pages 2-4 of this second Office Action. However, applicant respectfully disagrees with the Examiner in these contentions.

In essence, the Examiner's rejection is one of obviousness and on that point it is believed that the

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decision of In re Piasecki, 223 USPQ 785,787-78 (Fed. Cir. 1984) is in point. In this case, the Court held that in proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. See In re Fine, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). Applicant submits that there is no teaching, suggestion, or incentive whatsoever in the prior art to Curry, Nabell et al., and Takeuchi to combine the teachings thereof in the manner as suggested by the Examiner.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absence of teaching or suggestion supporting the combination. Under Section 103, teachings of the references can be combined only if there is some suggestion or incentive to do so. ACS Hosp. Systems, Inc. v Montefiore Hosp., 221 USPQ 929,933 (Fed. Cir. 1984). In this case, it is submitted by applicant that neither Curry, Nabell et al., nor Takeuchi, alone or in combination, provide any incentive

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to combine the teachings of the prior art as alleged by the Examiner.

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested desirability of the modification. See In re Gordon, 221 USPQ 1125,1127 (Fed. Cir. 1984). It is submitted that Curry, Nabell et al., and Takeuchi fail to suggest any motivation for, or desirability of, the suggested changes as contended by the Examiner.

It is believed that the Examiner in making these substitutions is being guided by what is disclosed by applicants' own specification and not by what is fairly taught or suggested by the cited prior art references. It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations. There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination. See Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543 311 (Fed. Cir. 1985).

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Nevertheless, and in an effort to better distinguish the present invention over the cited prior art, applicant has canceled Claims 11 and 18 and has now once again amended independent Claims 9 and 16. It is submitted that none of the cited prior art references can, singly or in any combination, be deemed to anticipate or make obvious all of the new and novel features as now recited with particularity in amended independent Claims 9 and 16.

Specifically, Claim 9 has been again amended so as to recite the structural details of the dual stage current limiting surge protector system. In particular, the protection protector system includes a first voltage suppressor 226; first and second fuse elements 238, 240; third and fourth fuse elements 248, 250; and a second voltage suppressor 252. Each of the third and fourth fuse elements is recited to have a lower rated current value than each of the first and second fuse elements. Further, the first and second fuse elements have a relatively high rated current value of about 350 ma so as to pass a UL standard test. The third and fourth fuse elements have a relatively low rated current value of about 175 ma so as to protect the equipment coupled to the output tip and ring terminals from being damaged.

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Likewise, Claim 16 has been again amended to recite the protector system to include a first voltage suppressor 226; first and second positive thermal coefficient resistors 238, 240; third and fourth positive thermal coefficient resistors 248, 250; and a second voltage suppressor 252. Each of the third and fourth positive thermal coefficient resistors is recited to have a lower rated current value than each of the first and second positive thermal coefficient resistors. Further, the first and second positive thermal coefficient resistors have a relatively high rated current value of about 160 ma so as to pass a UL standard test. The third and fourth positive thermal coefficient resistors have a relatively low rated current value of about 80 ma so as to protect the equipment coupled to the output tip and ring terminals from being damaged.

The Curry reference merely discloses a line protector for a communication circuit which includes first and second isolation circuits 38, 38'; a first voltage suppressor 40; third and fourth isolation circuits 48, 48'; and a second voltage suppressor 64. However, it does not teach or suggest the high rated current values of the first and second fuse elements or positive thermal coefficient resistors 238, 240 for passing the UL test and the low rated current values of the third and fourth fuse elements or positive thermal

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coefficient resistors 248, 250 for protecting the equipment from damage. It is submitted that this broad and general teaching of Curry cannot in any way be deemed to anticipate or make obvious the present invention as recited in amended Claims 9 and 16.

It is noted that the secondary references to Nabell et al. and Takeuchi as cited by the Examiner are both likewise deficient in their teachings of the high and low rated current values of the fuse elements and positive thermal coefficient resistors of the present invention as recited in amended independent Claims 9 and 16.

As previously pointed in the earlier prosecution, the secondary reference to Nabell et al. merely discloses a circuit for protection of communication lines which includes first and second fuses 105, 106 connected in series with the unprotected side of the respective tip and ring lines; an over-voltage protection device 109 connected to both the tip and ring lines at a point intermediate the protected side and the unprotected side; and first and second PTC elements 107, 108 connected in series with the protected side of the tip and ring lines. The secondary reference to Takeuchi only discloses a protection device for a communication system which includes a series connected PTC thermistor 15 and a thick-film resistor 26 extending between the tip input and output terminals and a

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series connected PTC thermistor 19 and a thick-film resistor 28 extending between the ring input and output terminals.

Therefore, it is believed that the proposed combinations as suggested by the Examiner, even if such combinations were possible, would still not realize all of the features of the present invention. Therefore, it is believed that the present invention as recited in amended independent Claims 9 and 16 is clearly distinguishable over the prior art of record and is therefore in condition for allowance.

Moreover, it is likewise submitted that Claims 12 through 14 being dependent upon amended independent Claim 9 should likewise be allowable for this reason alone. Similarly, Claims 19 through 21 being dependent upon amended independent Claim 16 should be likewise be allowed.

In view of the foregoing discussion and amendments advanced to the claims, it is now believed that amended independent Claims 9 and 16 and the remaining claims dependent thereon have been placed in condition for allowance. Therefore, a formal Notice of Allowability is believed to be in order and the same is earnestly solicited.

Alternatively, should the Examiner not permit the allowance of this case, then entry of this Amendment is

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solicited on the grounds that the application will be placed  
in better form for an Appeal.

In the event the Examiner is of the opinion that the  
prosecution of this application may be expedited by direct  
contact with applicants' attorney, he is requested to call  
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Respectfully submitted,

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